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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,845	10/17/2003	Antonella Pesce	CM2526C	9579

27752 7590 07/19/2007
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EXAMINER

ARNOLD, ERNST V

ART UNIT	PAPER NUMBER
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1616

MAIL DATE	DELIVERY MODE
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07/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/687,845	Applicant(s) PESCE ET AL.	
	Examiner Ernst V. Arnold	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/21/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/21/07 has been entered.

Claims 1-9 have been cancelled. Claims 10-20 are under examination.

Withdrawn rejections:

Claims 10-15, 18 and 19 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 6-10, 13, and 14 of copending Application No. 10/687,897. The Examiner made a typographical error. The proper Application number is 10/687,687 and has issued as US 6,972,010.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 18 recites the limitation "formulae (II)" in line 2. There is insufficient antecedent basis for this limitation in the claim. Claim 10 does not contain a formulae (II). The claim will be examined as it reads on triethyl citrate, acetyl tributyl citrate and/or triacetyl citrate.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (US 6,506,958) in view of Hasegawa et al. (US 5,364,626).

Applicant claims a hygienic article comprising a composition comprising a cooling agent with an ester derivative.

Determination of the scope and content of the prior art

(MPEP 2141.01)

Williams teaches a signal tampon with an indicator designed to provide a sensory signal to the user (Abstract). The sensory signal can be a cold sensation produced by such materials as menthyl lactate (a cyclohexyl structure), menthol, ethanol or combinations thereof (Column 4,

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lines 1-10 and claim 16). It is the Examiner's position that the teaching of Williams suggests combining a first cooling agent, menthol, with a second cooling agent such as menthyl lactate.

Hasegawa et al. provide a teaching where esters of citric acid, such as triethyl citrate, are used to provide a sustained release effect for repelling materials on fibers (Column 2, lines 17-30; column 5, lines 60-64 and claims 1 and 2). Hasegawa et al. teach that certain repellants are menthol, spearmint oil, L-carvone, and camphor, for example (Column 2, lines 8-18). Hasegawa et al. teach the total amount of citric acid esters and glycols is in the range of 1 to 9 parts by weight per 1 part by weight of a repellant (Claim 3).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

1. Williams do not expressly teach the signal tampon with an ester derivative.
2. Williams do not expressly teach the signal tampon with a first cooling agent and a second cooling agent in a weight ratio of 1/1 to 1/100.
3. Williams do not expressly teach the signal tampon wherein the cooling agent or a mixture thereof is present at a level of about 0.1% to about 99.9% and wherein the ester derivative or a mixture thereof is present at a level of from 99.9% to 0.1% by weight of the total composition.
3. Williams do not expressly teach the article wherein the composition is suitable for topical application to the external surface of a mammal in the form of a cream, lotion, emulsion, dispersion, gel, foam, oil, ointment or powder.

Finding of prima facie obviousness

Rational and Motivation (MPEP 2142-2143)

1. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to add an ester of citric acid, such as triethyl citrate, as suggested by Hasegawa et al. to the hygienic article, tampon, of Williams and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because Hasegawa et al. teach that a cooling agent such as menthol can have prolonged release in the presence of compounds like triethyl citrate. One of ordinary skill in the art would want to add the triethyl citrate in order to increase the shelf life of the product.

2. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to add a first cooling agent and a second cooling agent in a weight ratio of 1/1 to 1/100 to the composition of Williams and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because Williams suggests combining cooling agents and it is merely routine optimization for one of ordinary skill in the art to arrive at the ratio of 1/1 to 1/100 by weight of the cooling agents.

3. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to add the cooling agent or a mixture thereof at a level of about 0.1% to about 99.9% and wherein the ester derivative or a mixture thereof is at a level of from 99.9% to 0.1% by weight of the total composition in the composition of Williams and produce the instant invention.

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One of ordinary skill in the art would have been motivated to do this because Williams and Hasegawa et al. provide the ingredients and it is merely routine optimization by one of ordinary skill in the art to arrive at the instantly claimed amounts.

4. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to make the article of Williams wherein the composition is suitable for topical application to the external surface of a mammal in the form of a cream, lotion, emulsion, dispersion, gel, foam, oil, ointment or powder.

One of ordinary skill in the art would have been motivated to do this because Williams teaches that the indicator can be in a hydrogel, which is a type of gel (Column 3, lines 51-52).

In the absence of any criticality/unexpected results, the presently claimed invention is considered *prima facie* obvious over the prior art for the reasons of record and those stated above.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA) 1976).

In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

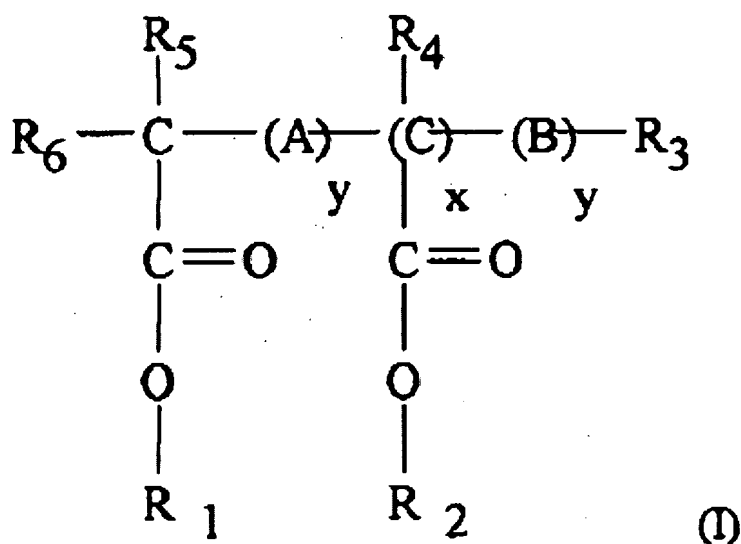
From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention.

Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

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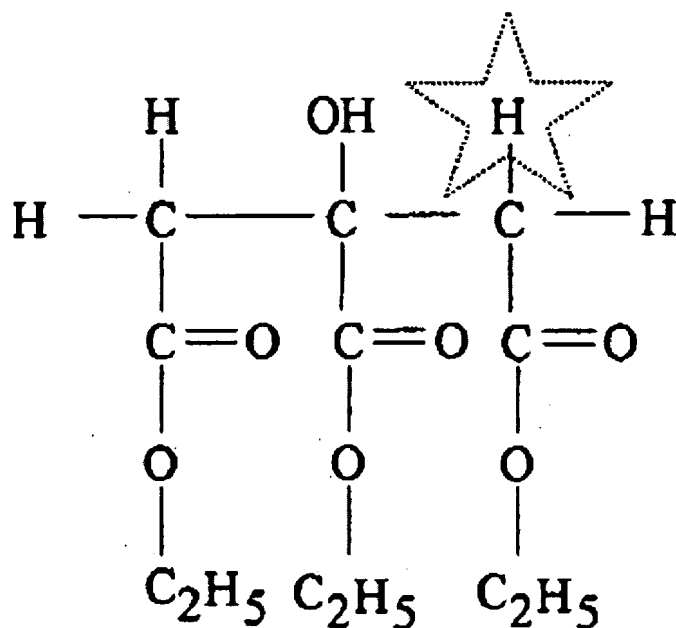
Response to arguments:

Applicants assert that the formula stated in the Office Action is not triethyl ester of citric acid. Applicant and the Examiner are at odds over the identity of R4. The structure in claim 10 is:



The Examiner stated that R4 is OH. Applicant and the Examiner are in agreement. Now in order to arrive at the triethyl ester of citric acid the structure above must be expanded by having $x = 2$. This creates a new R4 that is not the same as the drawn R4 in claim 10. The new R4 does not have to be OH. Claim 10 recites that R4 can be independently hydrogen. The final structure is then:

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**Claim Rejections - 35 USC § 103**

Claims 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brunner et al. (US 5,733,272) in view of Furman (US 5,451,404) which is relied upon for the teachings related to instant claims 15 and 16.

Applicant claims a hygienic article comprising a composition comprising a cooling agent with an ester derivative.

Determination of the scope and content of the prior art

(MPEP 2141.01)

Brunner et al. teaches an article of manufacture selected from the group consisting of pantliners, diapers, adult incontinence garments and underarm shields comprising an effective amount of moisture activated encapsulated perfume from about 0.001 g to about 10 g (Claims 1 and 4). There is from about 0.01 to about 15 g of odor-controlling agent (Claim 4). Brunner et al. teach that the perfume is selected from the group consisting of highly volatile perfume, moderately volatile perfume and mixtures thereof (Claim 2). The perfumes can be eucalyptol and triethyl citrate, for example (column 3, line 35-column 4, line 22). Mixtures of the perfumes read on the instantly claimed cooling agent and ester derivatives. The perfume can be present in the topsheet (column 2, lines 43-47 and column 12, line 32-67). Brunner et al. teach that the moisture activated encapsulated perfume has a particle size of less than about 12, 10, 8 and 5 microns which, in the absence of evidence to the contrary, reads on a powder (Claims 6-9). Brunner et al. teach that the article contains an effective amount of odor controlling materials (column 7, lines 30-32).

Furman teaches cooling compositions comprising a ketal and a secondary coolant, which may be menthol, carboxamides or mixtures thereof (Abstract; and claims 1-10). The compositions can be applied to the body (column 5, line 57 and include toilet articles (column 6, lines 11-12 and claim 8). The composition can be formulated into a carrier such as solids, liquids, emulsions, foams and gels (column 6, lines 19-32).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

1. While Applicant claims a hygienic article comprising a composition comprising a cooling agent together with an ester derivative, Brunner et al. do not expressly teach a hygienic article comprising a composition comprising a cooling agent together with an ester derivative.

2. While Applicant claims a hygienic article wherein the cooling agent is menthol and/or peppermint oil in combination with a second cooling agent selected from the group consisting of ketals, carboxamides, cyclohexyl, cyclohexonal and mixtures thereof, Brunner et al. do not expressly teach a hygienic article wherein the cooling agent is menthol and/or peppermint oil in combination with a second cooling agent selected from the group consisting of ketals, carboxamides, cyclohexyl, cyclohexonal and mixture thereof. The teachings of Furman are relied upon to cure this deficiency in Brunner et al.

3. While Applicant claims a hygienic article with a first cooling agent and a second cooling agent in a weight ratio of 1/1 to 1/100 and Brunner et al. do not expressly teach the hygienic article wherein the cooling agent or a mixture thereof is present at a level of about 0.1% to about 99.9% and wherein the ester derivative or a mixture thereof is present at a level of from 99.9% to 0.1% by weight of the total composition, Brunner et al. do not expressly teach the a hygienic article with a first cooling agent and a second cooling agent in a weight ratio of 1/1 to 1/100 and Brunner et al. do not expressly teach the hygienic article wherein the cooling agent or a mixture thereof is present at a level of about 0.1% to about 99.9% and wherein the ester derivative or a mixture thereof is present at a level of from 99.9% to 0.1% by weight of the total composition.

Finding of prima facie obviousness

Rational and Motivation (MPEP 2142-2143)

1. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to make the article of Brunner et al. with a cooling agent together with an ester derivative and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because Brunner et al. teach mixtures of the perfumes some of which can serve as cooling agents and others can serve as ester derivatives as discussed above. It is the Examiner's position that cooling agent would convey a feeling of freshness sensation.

2 and 3. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to make the article of Brunner et al. wherein the cooling agent is menthol and/or peppermint oil in combination with a second cooling agent selected from the group consisting of ketals, carboxamides, cyclohexyl, (taught by Furman) cyclohexonal and mixtures thereof, as taught by Furman, and produce the instant invention. It is obvious to combine the compositions because each is taught in the art for the same purpose: toilet articles.

One of ordinary skill in the art would have been motivated to do this because Brunner et al. teach adding odor-controlling materials to the composition and it is known in the art that menthol has a pleasant odor and would be odor controlling. It is deemed merely a matter of judicious selection of agents by one of ordinary skill in the art. Furthermore, it is merely routine optimization of the amounts of 'cooling agent/ odor-controlling agent' and 'ester derivative' based on the teachings of Brunner et al. to arrive at the instantly claimed weight ratio of instant claim 17 and amounts in instant claim 19 (See claim 4 of Brunner et al.).

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A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA) 1976).

In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention.

Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

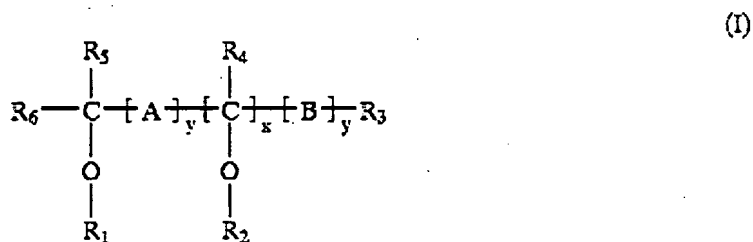
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

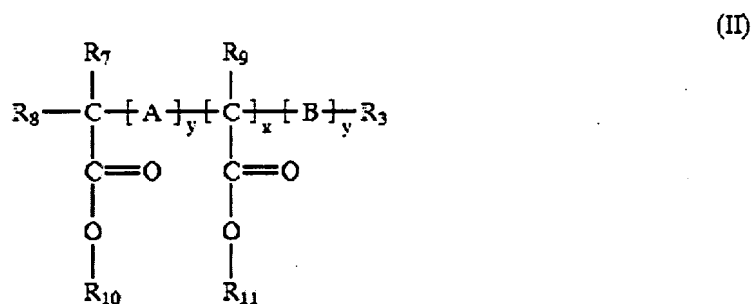
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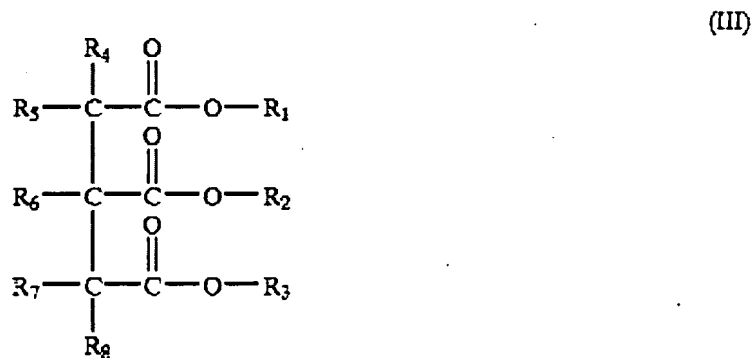
Claims 10-15 and 18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,972,010. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the instant application is embraced by the claimed subject matter in the patent.

Claim 1 of US 6,972,010 is drawn to an absorbent article comprising an agent able to convey a perception to the wearer and a delivery system for containing and delivering the agent to the skin. Claim 1 of US 6,972,010 also recites wherein the delivery system comprises an alcohol or ester derivative of the following formulae:



or





Thus, the instant ester derivatives are fairly taught in US 6,972,010. The article and agent are not described in the claim language. The Examiner notes that: MPEP § 804 (II) states, "When considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992). This does not mean that one is precluded from all use of the patent disclosure." (*emphasis added*). "Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970)."

Therefore, the Examiner looked to the specification for guidance on the type of agent and type of article. The article is described as being panty liners, for example, with topsheets and backsheets fully discussed (Column 25, line 1 through column 33, line 57). The agent is disclosed as being derivatives of ketals, carboxamides, cyclohexanol, cyclohexyl as well as a

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number of oils such as peppermint oil that can convey a perception, freshness sensation, to the wearer (Column 7, line 13 and 46 through column 14, line 60). One of ordinary skill in the art would have recognized the obvious variation of the instant invention over US 6,972,010 due to the overlap in claimed subject matter as described above.

II. Claims 10-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-6 and 8-13 of copending Application No. 11/106,402. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter is embraced by the subject matter of the copending application. The copending application claims an absorbent article, such as a panty liner, comprising an agent able to convey a perception to the wearer wherein the agent is a cooling agent selected from the group consisting of ketals, carboxamides, cyclohexyl derivatives, etc....(Claims 2-5). The article comprises a delivery system which is an emollient containing composition comprises from about 0.1% to about 99.9% by weight of the agent and from about 99.1% to about 0.1% by weight of the emollient and the delivery system comprises triethyl citrate (claims 8-11). The article comprises a topsheet (claims 12-13). The article comprises menthol as a first cooling agent in combination with a second cooling agent (Claim 6). One of ordinary skill in the art would have recognized the obvious variation of the instant invention over the copending claims due to the overlap in subject matter as described above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to arguments:

Applicant agrees to submit terminal disclaimers upon indication of allowable subject matter. Until such a time the claims remain rejected.

Conclusion

No claims are allowed.

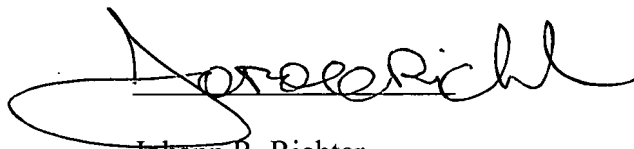
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernst V. Arnold whose telephone number is 571-272-8509. The examiner can normally be reached on M-F (6:15 am-3:45 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ernst Arnold
Patent Examiner
Technology Center 1600
Art Unit 1616

A handwritten signature in black ink, appearing to read "Johann R. Richter", written over a horizontal line.

Johann R. Richter
Supervisory Patent Examiner
Technology Center 1600